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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,436

Applicant(s)

KARAOGUZ ET AL.

Examiner

JEREMY DUFFIELD

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. In view of the Appeal Brief filed on 11 March 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Arguments

2. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman (US 2002/0112239) in view of Hendricks (US 5,600,364).

Regarding claim 1, Goldman teaches a method of communicating activity information to support user and user base profiling and consumption feedback in a communication network, the method comprising:

establishing at a first location, from a second location, at least one parameter related to monitoring media consumption activity of a user at a first location, i.e. the requesting of specific viewer behavior information 98, containing type & volume of data pertaining to media consumption activity, from a user at a 1st location (home entertainment system 90) by a clearinghouse system 100, at a 2nd location (Figs. 1-3; paragraph [0037]);

receiving, at the first location, a media request from the user, the requested media having an associated set of pre-defined characteristics, i.e. the tracking of viewer behavior information related to user at 1st location, 90, making a request to tune or display a television program, whereby the identification of the requested media is made possible by information contained within an EPG (paragraph [0032-0035]);

determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter, i.e. a home entertainment system, 90, matching specific data requested by the clearinghouse system 100 with that of the

data of the program being tracked (paragraphs [0036-0037]), for example: coupling IDs of programs viewed from an EPG to an occurrence of the program being viewed based on data remotely requested from the clearinghouse, then storing the IDs as an instance of viewer behavior information (Para. 36-37);

sending notification of the media request to a second location, via a communication network, if the determining results in a match, i.e. sending requested data, which may include a channel ID, program ID, etc, back to the clearinghouse (Figure 2; paragraphs [0037] & [0043]).

Goldman does not explicitly teach refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match.

Hendricks teaches storing user media requests at the set-top box (Col. 26, lines 26-40);

a network controller periodically polls the set-top box for the stored media requests, wherein the polling request message can include information such as a set-top box identifier, subscriber region designation, program name, program length, menu code, description, etc (Tables A, B, C; Col. 26, lines 11-40);

if the user has accessed programs after the previous polling cycle, then the number of programs accessed and their associated event identification numbers are sent in a response back to the network controller (Col. 28, lines 3-15);

if the user has not accessed programs after the previous polling cycle, then the set-top box sends a response that denotes zero programs accessed (Col. 28, lines 3-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goldman to include refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match, by incorporating the polling techniques taught by Hendricks with the information requesting technique of Goldman, for the purpose of providing the information requester with a response to every information request thereby making the entire communication system more efficient.

With respect to Claim 2, the claimed "wherein the first location is associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN)" is met by Goldman that teaches Claim 1 and the use of an addressable set-top box, within home entertainment system 90, that sends select viewer behavior information using the Internet (paragraph [0010] & [0040]). The claimed "Internet protocol (IP) address" is not explicitly taught by the Goldman reference. The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

With respect to Claim 3, the claimed “wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure” is met by Goldman that teaches Claim 1 in which the communication network 110 can include a cable, optical, terrestrial antenna system, satellite system etc. (Fig1; paragraph [0029]).

With respect to Claim 4, the claimed “wherein the communication network is the Internet” is met by Goldman that teaches the use of an Internet connection by a user at the 1st location, home entertainment system 90, in sending pertinent viewer behavior information 98 (Fig.1; paragraphs [0040] & [0060]).

With respect to Claim 5, the claimed “wherein the media comprises one or more of audio, a still image, video, real time video, and data” is met by Goldman that teaches video data corresponding to broadcast 88 being delivered to a 1st user at home entertainment system 90 (Fig.1; paragraphs [0029] & [0035]).

With respect to Claim 6, the claimed “wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data” is met by Goldman that teaches the use of a display device 92 at a 1st location (home

entertainment system 90) for the displaying of broadcast programming, such as video data (Fig. 1 & 2; paragraphs [0022], [0027], [0031], & [0035]).

With respect to Claim 7, the claimed "wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used" is met by Goldman that teaches a central clearinghouse 100 indicating specific viewer behavior information that it desired to be tracked, such as: channel ID, subscriber ID, program ID & title, city & state of channel, and the current date & time (Goldman-paragraph [0037]; Hendricks-Col. 26, lines 26-61).

With respect to Claim 8, the claimed "wherein the associated set of pre-defined characteristics comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, and/or a language" is met by Goldman that teaches the use of an EPG in making available data for viewer behavior information 98, the data pertaining to: provider of broadcast, type of broadcast, date & time of broadcast, origination of broadcast, manner in which broadcast is being supplied, title of program, episode, director of program, actors, program ratings, etc. (Goldman-paragraph [0034]; Hendricks-Col. 28, lines 3-15).

Claim 9 is met as previously discussed with respect to Claim 1. Goldman in view of Hendricks further teaches creating at least one record of the media request, at the second location; and sharing information derived from the at least one record with a third party, i.e. the use of a storage device 104 for the gathering of viewer behavior information 98 at the clearinghouse system 100, the creation of a viewer behavior information report 109, and the transmittal of 109 to a third party, signal source 80 (Goldman-Fig. 3; paragraphs [0043] & [0048]; Hendricks-Col. 29, line 54-Col. 30, line 49).

Claim 10 is met as previously discussed with respect to Claim 2.

Claim 11 is met as previously discussed with respect to Claim 3.

Claim 12 is met as previously discussed with respect to Claim 4.

Claim 13 is met as previously discussed with respect to Claim 5.

Claim 14 is met as previously discussed with respect to Claim 6.

Claim 15 is met as previously discussed with respect to Claim 7.

Claim 16 is met as previously discussed with respect to Claim 8.

With respect to Claim 17, the claimed “wherein the third party is at least one of a third party media provider, a third party service provider, and a third party sales provider” is met by Goldman that teaches the method of Claim 9 and the transmittal of a

viewer behavior information report 109 to a third party service provider, signal source 80 (Fig.3; paragraph [0048]).

With respect to Claim 18, the claimed "wherein the sharing uses the communication network" is met by Goldman that teaches the method of Claim 9 and the sharing of viewer behavior information report 109 with signal source 80 via the communication network 110 (Fig.3; paragraph [0048]).

Claim 19 is met as previously discussed with respect to Claim 1. Goldman in view of Hendricks further teaches a 1st location, home entertainment system 90, which may consist of a addressable set top box {storage device 96, processor 94} & a television {display device 92}, using an EPG for the selection of video data, and the transmittal of information related to media selected for media consumption {viewer behavior information 98- which may contain subscriber ID, channel ID, program ID and title, etc.}, via the internet, to server software {clearinghouse system 100} which stores sent info {storage device 96} (Goldman-Figs.1-3; paragraphs [0027], [0033-0035], [0040-0042], & [0043]).

Furthermore, with respect to the claimed "the server software sending notification of a media request to a second location based on a determination as to whether a set of predefined characteristics associated with the requested media matches at least on parameter related to monitoring media consumption activity at the first location" is met by Goldman that teaches the transmittal of compiled viewer behavior reports to

numerous 2nd locations, home entertainment systems 90a-d, based upon whether or not select viewer behavior information 98, from home entertainment systems matches those requested by the clearinghouse system 100 and Hendricks that teaches receiving a polling response that includes the set-top box identifier, subscriber address, and program access data (Goldman-Figs.2, 3; paragraphs [0037], [0043],[0045]; Hendricks-Col. 27, line 49-Col. 28, line 15).

Claim 20 is met as previously discussed with respect to Claim 5.

Claim 21 is met as previously discussed with respect to Claim 6.

Claim 22 is met as previously discussed with respect to Claim 2.

Claim 23 is met as previously discussed with respect to Claim 3.

Claim 24 is met as previously discussed with respect to Claim 1.

Claim 25 is met as previously discussed with respect to Claim 7.

With respect to Claim 26, the claimed "server software that shares, with a third party, information derived from the received data" is met by Goldman that teaches the system of Claim 19, and the transmittal of a viewer behavior information report 109, by clearinghouse system 100, to a third party service provider, signal source 80 (Fig.3; paragraph [0048]).

Claim 27 is met as previously discussed with respect to Claim 8.

Claim 28 is met as previously discussed with respect to claims 1 and 19.

Claim 29 is met as previously discussed with respect to Claim 5.

Claim 30 is met as previously discussed with respect to Claim 6.

Claim 31 is met as previously discussed with respect to Claim 2.

Claim 32 is met as previously discussed with respect to Claim 3.

Claim 33 is met as previously discussed with respect to Claim 1.

Claim 34 is met as previously discussed with respect to Claim 7.

With respect to Claim 35, the claimed "wherein the software shares, with a third party, information derived from the received data" is met by Goldman teaching the use of a storage device 104 for the gathering of viewer behavior information 98 at the clearinghouse system 100, the creation of a viewer behavior information report 109, and the transmittal of 109 to a third party, signal source 80 (Fig. 3; paragraphs [0043] & [0048]).

Claim 36 is met as previously discussed with respect to Claim 8.

With respect to Claim 37, the claimed "wherein the software comprises server software" is met by Goldman teaching the use of a clearinghouse system 100 in the compilation/creation a viewer behavior information report (Fig.3; paragraphs [0043]-[0045]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEREMY DUFFIELD whose telephone number is (571)270-1643. The examiner can normally be reached on Mon.-Thurs. 8:00 A.M.-5:30 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10 June 2009
JSD

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427